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| In re Application of | : | |
| DUBOIS | : | DECISION ON |
| Application No.: 09/194,996 | : | |
| PCT No.: PCT/FR97/01024 | : | RENEWED PETITION |
| Int. Filing Date: 10 June 1997 | : | |
| Priority Date: 11 June 1996 | : | UNDER 37 CFR 1.47(b) |
| Attorney's Docket No.: 146.1309 | : | |
| For: TRANSDERMIC SYSTEMS ... | : | |
| MEDICAMENTS | : | |

This decision is in response to the renewed petition under 37 CFR 1.47(b) filed 21 March 2000 and the supplement to the renewed petition filed 23 March 2000.

BACKGROUND

On 10 June 1997, applicant filed international application PCT/FR97/01024, which claimed a priority date of 11 June 1996. A copy of the international communication was communicated to the United States Patent and Trademark Office from the International Bureau on 18 December 1997. A Demand for international preliminary examination in which the United States was elected, was filed on 31 December 1997, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 11 December 1998.

On 04 December 1998, applicant filed, in the United States Patent and Trademark Office (USPTO), a transmittal letter requesting entry into the U.S. national stage, which was accompanied by, *inter alia*, the requisite U.S. basic national fee and an unexecuted declaration.

On 20 April 1999, the USPTO mailed applicants a NOTIFICATION OF MISSING REQUIREMENTS (PCT/DO/EO/905) and a NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (PCT/DO/EO/917) which indicated that the oath or declaration was not properly executed, and set a one month time period for response.

On 20 September 1999, applicants filed a "COMPLETION OF APPLICATION". The submission included, inter alia, a petition under 37 CFR 1.47(b); a declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventors; a "Declaration Under Rule 47" by Jean-Claude Vieillefosse (hereinafter "first declaration of facts"); and Exhibits A-F:

- Exhibit A, a declaration of designation of inventors signed by Mr. Dubois;
- Exhibit B, copy of French law;
- Exhibit C, copy of employment contract;
- Exhibit D, copy of letter written to Mr. Dubois on 09 November 1998;
- Exhibit E, copy of fax to Mr. Dubois sent on 02 December 1998; and
- Exhibit F, copy of letter forwarded to Mr. Dubois on 30 December 1998.

On 14 February 2000, the USPTO mailed a decision dismissing applicant's petition under 37 CFR 1.47(b). Specifically, the decision noted that the following had not been provided: factual proof that the inventor refuses to execute the application; a statement of the last known address of the inventor; an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application.

On 21 March 2000, applicants filed the present renewed petition under 37 CFR 1.47(b). The renewed petition was accompanied by a "Supplemental Declaration Under Rule 47" (hereinafter "second declaration of facts") by Jean-Claude Vieillefosse.

On 23 March 2000, applicants filed a "Supplement to the Renewed Petition" accompanied by an "Extract from the minutes of the Board of Executive Directors' deliberations dated Thursday 10 December 1998 at 2:00PM" and an English translation thereof.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. It was noted in the decision mailed 14 February 2000 that applicant has satisfied items (1) and (6) above.

In regard to item (5) above, the decision mailed 14 February 2000 noted that sufficient proprietary interest in the application had not been demonstrated because an affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by an

employee while employed by the 37 CFR 1.47(b) applicant had not been provided. The decision mailed 14 February 2000 also stated that if the Declaration for Designation of Inventors (Exhibit A) was to be relied upon, an English translation should be provided and that if the French Law Section is to be relied upon for showing proprietary interest rather than the employment contract, a legal memorandum as described in the last paragraph of MPEP 409.03(f) would be required. Neither an English translation nor a legal memorandum have been provided. Rather, the second declaration of facts states that "Jean-Claude Vieillefosse is an European patent attorney as well as a licensed French patent agent and under French law and Mr. Dubois' employment contract which are of record in the present application with English translation thereof, Mr. Dubois is required to assign all inventions to Hoechst Marion Roussel". Even assuming *arguendo* that this statement was intended as the legal memorandum referred to above, it would not be sufficient, at least because the legal conclusion reached appears to be inaccurate. Mr. Vieillefosse states that "Mr. Dubois is required to assign all inventions to Hoechst Marion Roussel". However, the English translation of Exhibit B suggests that there are limitations on inventions which must be assigned. The last paragraph of MPEP § 409.03(f) is reproduced below in the event that applicant would like to provide such a memorandum.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Note that any such memorandum should be supported by facts made of record by way of an affidavit or declaration of the person having firsthand knowledge of the facts.

As to item (4), the declaration must be made by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor. The submissions filed 21 March 2000 and 23 March 2000 make clear that Jean-Claude Vieillefosse has authority to sign the declaration on behalf of Hoechst Marion Roussel. However, it is not clear that the most recent address of Mr. Dubois has been provided. MPEP 605.03 states in part:

In situations where an inventor does not execute the oath or declaration and the inventor is not deceased, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary.

As stated in the decision mailed 14 February 2000, the declaration on behalf of and as agent for the nonsigning inventor lists a former place of residence and address of DUBOIS (17 rue Anatole France, 91120 Palaiseau, France), and the address of his current employer Sanofi Recherche, (371 rue du Professeur Blayac, 34000 Montpellier, France). These two addresses also appear

throughout the other submitted documentation and correspondences. A further address (63 rue de Meauz, 75019 Paris, France) is listed as the residence of DUBOIS on the Attestation of employment prepared by Jocelyne Saulquin on 28 April 1999, and was the address used in the correspondence from Manuela Louvet to DUBOIS dated 9 November 1998. Clarification as to the last known address of DUBOIS is required.

As to item (3), the renewed petition states that the "last address of Mr. Dubois was set forth in Mr. Vieillefosse's previous declaration". However, the first declaration of facts by Mr. Vieillefosse fails to set forth the last known address of Mr. Dubois. Also, as noted above regarding item (4), clarification as to the last known address is required.

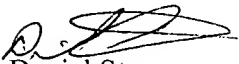
As to item (2), petitioner has provided sufficient proof that the missing inventor, Mr. Dubois, refuses to execute the application. The second declaration of facts establishes, by a person with first-hand knowledge, an oral refusal by Mr. Dubois to execute the present application. The evidence of record also indicates that Mr. Dubois was presented with a copy of the application papers, including the specification (first declaration of facts). Consequently, item (2) has been satisfied.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)", whichever is appropriate. No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the PCT Legal Office.



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